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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
10/673,093	09/26/2003	Steven E. Brown	03073CIP	7533												
7590 Martha Ann Finnegan, Esq. Cabot Corporation 157 Concord Road Billerica, MA 01821-7001		07/12/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">ALEXANDER, LYLE</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1743</td><td></td></tr><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>07/12/2007</td><td>PAPER</td></tr></table>		EXAMINER		ALEXANDER, LYLE		ART UNIT	PAPER NUMBER	1743		MAIL DATE	DELIVERY MODE	07/12/2007	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/673,093	Applicant(s) BROWN ET AL.	
	Examiner Lyle A. Alexander	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-134 is/are pending in the application.
- 4a) Of the above claim(s) 41-55 and 61-134 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 and 56-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/19/05,7/21/05, 3/7/05, 12/2/04 and 10/14/03 .

Claim Rejections - 35 USC § 112

Claims 1-40 and 56-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 are confusing what parameters are intended by "homogeneous" and "heterogeneous". Claims 2-3 give the same descriptions to both "homogeneous" and "heterogeneous" parameters.

The claims are also not clear how the candidate of a particular material is selected. Claim 4 is confusing because the basis of the selection is never described.

Claim 5 never describes how or what is the relationship.

Claims 10 and 12 are confusing how the matrix could be a solvent. Additionally, claim 10 is confusing what is the other particulate material.

Claim 13 is not clear what absorptometry methods are intended.

Claims 16-17 are not clear what is intended by a wicking rate method and how the claimed organic compounds are used in such a method.

Claims 18-20 are not clear what is intended by a yield point method and how the claimed hydrocarbons are used in such a method.

Claims 21-22 are not clear what is intended by an interfacial potential vapor absorption method and how the claimed organic compounds are used in such a method.

Claims 23-24 are not clear what is intended by an IGC method and how the claimed organic compounds are used in such a method.

Claim 25 is not clear how these listed properties are measured/quantified to yield performance properties.

Claim 26 is not clear what magnitude of "differences" yields the claimed relationships.

Claim 27 is not clear what is the morphological value.

Claim 28 is not clear how the particular material is selected and based upon what type of chemical value.

Claims 29-31 are not clear how the interfacial potential property value is determined/derived.

Claims 32-34 are not clear what is intended by a surrogate matrix, how the surrogate matrix is determined and what/how further manipulations of the surrogate matrix are made.

Claims 35-38 are not clear how the candidate is selected, what is the performance property, what and how the surrogate matrix is selected and what are the "homogeneous" and "heterogeneous" parameters.

Claims 39-40 are not clear how the interfacial potential properties values are determined. Additionally, claim 40 includes a typographical error by reference to "claim 29". The Office will assume Applicants' intended to be dependent upon "claim 39".

Claims 56-60 are not clear how the matrix is selected, what is the matrix, how the parameters are manipulated and what are the interaction parameters.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-40 and 56-60 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Webster et al. (USP 3,229,507), Barkalow et al. (USP 5,405,623) or Shtarkman et al. (USP 4,992,190).

In light of the 35 USC 112 second paragraph issues above, the invention is best understood as a method of determining a particulate in a polymer matrix.

Barkalow et al. teach a method for monitoring the amount of sorbitol in a polymer matrix (e.g. chewing gum).

Shtarkman teach magnetized particles in a silica gel dispersant and a vehicle.

Webster teach a method of determining the properties of carbon black.

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 4/24/07 is acknowledged. The traversal is on the ground(s) that there is no additional burden of search. This is not found persuasive because the basis for making a restriction is if there are more than one independent and distinct inventions. The 4/4/07 restriction requirement demonstrated several distinct and independent inventions.

The requirement is still deemed proper and is therefore made FINAL.

The Examiner acknowledges receipt of the lengthy information disclosure statement filed 12/19/05, 7/21/05, 3/7/05, 12/2/04 and 10/14/03. There is no

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requirement that applicants explain the materiality of English language references, however the cloaking of a clearly relevant reference in a long list of references may not comply with applicants' duty to disclose, see Penn Yan Boats, Inc. v. Sea Lark Boats, Inc., 359 F. Supp. 948, aff'd 479 F. 2d. 1338. There is no duty for the Examiner to consider these references to a greater extent than those ordinarily looked at during a regular search by the Examiner. Accordingly, the Examiner has considered these references in the same manner as references encountered during a normal search of Office search files.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A. Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lyle A Alexander
Primary Examiner
Art Unit 1743

